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EXAMINER

JACOBSON, MICHELE LYNN

ART UNIT	PAPER NUMBER
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1782

NOTIFICATION DATE	DELIVERY MODE
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12/09/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

eofficemonitor@woodcock.com

Office Action Summary	Application No. 10/566,319	Applicant(s) ADAMS ET AL.	
	Examiner MICHELE JACOBSON	Art Unit 1782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, 8-10, 12, 14, 16-18 and 20-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 8-10, 12, 14, 16-18 and 20-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/9/10 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3, 6, 8-10, 12, 14, 16-18 and 20-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 16,

Art Unit: 1782

21, 24 and 25 all recite that the woven polymer mesh is “bonded” to a paper layer “by means of an intermediate layer of” polypropylene. If the means that the bonding is being accomplished with is polypropylene, polypropylene material is therefore acting as an adhesive. There is no disclosure of a polypropylene *adhesive* layer for *bonding* the mesh layer to a paper layer in applicant’s originally filed specification. There is however support for the *presence* of a polypropylene layer in original claim 1. The examiner suggests that applicant consider deleting the limitation “bonded” by means of a polypropylene layer. Claims 2, 3, 6, 8-10, 12, 14, 17, 18, 20, 22, 23 and 26-29 are rejected for being dependent from claims containing new matter and therefore also incorporating new matter. Appropriate correction is required.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 14 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 14 and 26 recite the limitation “paper-paper adhesive”. The recitation in applicant’s specification that an example of a “paper-paper adhesive” is polyvinyl acetate does not provide a definition for the term “paper-paper adhesive”. It is also unclear from the recitation of “paper-paper adhesive” what materials would be excluded from being considered to infringe on the limitations of claims 14 and 26. Therefore, one

Art Unit: 1782

of ordinary skill in the art would not be reasonably apprised of the full scope and breadth of the invention claimed. Since it is unclear what is meant by "paper-paper adhesive" for the purpose of examination any adhesive material will be interpreted to read on the limitations of claims 14 and 26. Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 6, 8-10, 12, 14, 16-18 and 20-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weekers U.S. Patent No. 5,328,142 (hereafter referred to as Weekers) and Fyfe U.S. Patent No. 6,295,782 (hereafter referred to as Fyfe).

9. Weekers teaches a spirally wound kraft paper tube for use in concrete column forming comprising at least one wound layer of water impermeable plastic film intermediate the paper layers. (Col. 1, lines 36-45) The polyethylene plastic layer renders the wall of the tube substantially impervious to the passage of water. (Col. 2, line 67-Col. 3, line 3)

10. Each of the paper layers has a thickness preferably less than 0.5 mm. (Col. 2, lines 56-57) The plastic layer may be a polyethylene film not greater than 0.3 mm thick

Art Unit: 1782

with the overall thickness of the tube wall preferably between 0.5 and 3 mm. (Col. 2, lines 57-66)

11. Weekers acknowledges that in view of the thin, flexible nature of the walls of the tube, it may not have sufficient integrity to be self-supporting in the case of relatively long tubes. Specifically, long tubes may tend to bulge, particularly at the bottom of the tube, from the weight of the concrete. To alleviate this problem, Weekers suggests using an additional split support tube held together with wires or bands which closely surround and support the forming tube. (Col. 3, line 61-Col. 4, line 9)

12. Weekers is silent regarding disposing a polymer mesh in between the paper and polyethylene layers.

13. Fyfe teaches a concrete forming tube comprising a composite shell made by spirally winding resin impregnated fabric layers around a liner. (Col. 2, lines 1-5) The fabric may comprise fibers such as polymeric materials like polyaramid, Kevlar, polyethylene and aramid. (Col. 4, lines 1-2)

14. The number of warp yarns per inch is preferably between about 5 and 20 and the number of fill yarns per inch is preferably between about 0.5 and 5. (Col. 4, lines 27-30) The fabric layers are recited to be impregnated with resin in order to function properly. The resin matrix selected must be tough and waterproof. (Col. 5, lines 25-34)

15. The liner material utilized is formed of water-resistant and impermeable material to protect the concrete core from moisture and corrosive materials as well as to protect the composite shell from the alkalinity in the concrete core. (Col. 6, lines 1-4)

Polyethylene is recited as a suitable liner material. (Col. 6, lines 5-6)

Art Unit: 1782

16. Both Weekers and Fyfe are directed towards concrete forming tubes comprising waterproof polyethylene layers that provide a means for supporting the concrete forming tube. Fyfe solves the problem of bulging of the concrete forming tube disclosed by Weekers by providing a resin impregnated wrapped textile reinforcement layer.

17. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have employed a resin impregnated textile reinforcement layer such as that disclosed by Fyfe in the invention of Weekers in order to provide structural reinforcement to the tube disclosed by Weekers and to solve the problem of the concrete forming tube bulging at the bottom. One of ordinary skill would have disposed the textile layer between the polyethylene and paper layers recited by Weekers since the polyethylene layer must necessarily be disposed on the interior of the tube to provide the function of protecting the concrete from water and protecting the forming tube from alkalinity as disclosed by Weekers and Fyfe respectively.

18. Regarding claims 1, 14, 16, 17, 21, 22, 24, 25 and 26: Fyfe discloses that the resin for the fabric layer must be tough and waterproof and both Weekers and Fyfe employ polyethylene as a waterproof material that must be tough to be in contact with the concrete used in the forms. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized polyethylene or HDPE as the resin for impregnating the fabric layer since polyethylene is both tough and waterproof. Such a multilayer laminate would comprise a sub-layer comprising a paper layer, a fabric layer impregnated with polyethylene which provides bonding to the paper layer and an additional a polyethylene layer. A spirally wound tube including such a

Art Unit: 1782

laminate formed by bonding the sublayers together in the conventional manner of forming butt joints would have been the same invention as claimed in claims 1, 14, 16, 17, 22, 24, 25 and 26.

19. Regarding claims 2 and 18: Regarding the thread density claimed, in the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990)

20. Regarding claims 3, 6 and 20: It would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected grammage weights and tensile strength of the materials used that would be appropriate for the concrete forming tube application. The obvious selection of materials of appropriate strength would have produced the same invention as claimed in claims 3, 6 and 20.

21. Regarding claims 8-10, 12 and 28: It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the tube produced by the combination of Weekers and Fyfe whatever thickness was necessary for the application the tube was intended to be used for. The thickness of the tube is a result effective variable that controls the strength of the tube. The obvious optimization of the thickness of the tubing would have produced tubes with the same thicknesses claimed in claims 8-10, 12 and 28 for use as concrete column forms. It is noted by the examiner that the limitations of “rigid” and “flexible” in claims 8 and 10 are of little patentable weight and are interpreted to be met by the obvious optimization of the thickness of the tube depending on the amount of strength required.

Art Unit: 1782

22. Although Weekers and Fyfe do not recite the intended use limitation of a roll core, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Any tubular structure such as the tubes disclosed by Weekers and Fyfe could be used as a core to receive something rolled around it and therefore the structure produced by the combination of Weekers and Fyfe reads on the invention claimed in claim 12.

23. Regarding claims 23 and 27: The combination of the teachings of Weekers and Fyfe provides a spirally wound tube having a polyethylene layer.

24. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weekers U.S. Patent No. 5,328,142 (hereafter referred to as Weekers) and Fyfe U.S. Patent No. 6,295,782 (hereafter referred to as Fyfe) as applied to claims 1, 14 and 26 above in further view of Cordeiro, C. F. 2000. Vinyl Acetate Polymers. Kirk-Othmer Encyclopedia of Chemical Technology. Published Online: 4 DEC 2000 (hereafter referred to as Cordeiro).

25. Weekers teaches what has been recited above but is silent regarding the adhesive used to bond the spirally bound kraft paper layers comprising a polyvinyl acetate adhesive.

Art Unit: 1782

26. Cordeiro discloses that polyvinyl acetate polymers are found as components in adhesives in construction products. (pg. 1, 13)

27. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used a polyvinyl acetate adhesive for the adhesive between the kraft paper layers disclosed by Weekers since polyvinyl acetate was universally known to those of ordinary skill in the art to be useful as an adhesive in construction products as evidenced by Cordeiro. The selection of a known material based on its suitability for its intended use supports a *prima facie* obviousness determination. ("Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle." *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious)) (MPEP 2144.07) The obvious modification of Weekers with Fyfe and Cordeiro would have produced the same invention as claimed in claim 29.

Response to Arguments

28. Applicant's arguments filed 11/9/10 have been fully considered but they are not persuasive.

Art Unit: 1782

29. Applicant's arguments on pages 7 and 8 of the remarks regarding the rejections under 112 first paragraph and 112 second paragraph have been addressed in the rejections above.

30. Applicant asserts on page 9 of the remarks that the instant invention is distinguished from the applied prior art because "the intermediate laminate layer claimed does not result in the full impregnation of the mesh and "oozing" into the textile to fill in the voids. Instead, the laminate layer attaches to the mesh and paper by simple surface bonding." However, none of the features enumerated by applicant are present in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the combination of references presented by the examiner is interpreted to obviate the instantly claimed invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELE JACOBSON whose telephone number is (571)272-8905. The examiner can normally be reached on Monday-Thursday 8:30 AM-7 PM EST.

Art Unit: 1782

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571)272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michele L. Jacobson/
Examiner, Art Unit 1782

Michele L. Jacobson
Examiner
Art Unit 1782